

### **REMARKS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. Claim 34 is amended without prejudice or disclaimer. New claims 37-39 are added herewith. Applicants file this RCE but also argue below that the finality of the Office Action was premature.

#### **Rejection of Claims 34 and 36 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 34 and 36 under 35 U.S.C. §103(a) as being unpatentable over Gever et al. (U.S. Patent No. 6,329,994) ("Gever et al.") in view of Noot et al. (CharToon 2.0 Manual) ("Noot et al.") and Herman et al. (U.S. Patent No. 6,075,905) ("Herman et al."). Applicants respectfully traverse this rejection and submit that the Examiner's response to arguments in one aspect has been non-responsive to Applicants' position and previous arguments regarding why one of skill in the art would not have sufficient motivation to combine these references. Applicants note that MPEP 2144.08, Section III, requires that once Applicant has presented rebuttal evidence, Office personnel should reconsider any initial obviousness determination in view of the entire record. All of the proposed rejections and their basis should be reviewed to confirm their correctness and only then should any rejection be imposed in the Office Action. "The Office Action should clearly communicate the Office's findings and conclusions, articulating how the conclusions are supported by the findings." The next paragraph is also important in terms of the current status of this case:

"Where applicable, the findings should clearly articulate which portions of the reference support any rejection. Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. §103 ground of rejection...conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings."

Applicants respectfully submit that this is where we stand in the present case. In the previous Office Action response, Applicants argued with regards to the Herman et al. reference that this reference was non-analogous and that one of skill in the art would not have sufficient

motivation (by a preponderance of the evidence) to combine Herman et al. with the remaining references. The rationale provided by Applicants was that fundamentally Herman et al. fail to teach anything regarding animation in the context of a background but rather their teaching focuses on creating an image mosaic that involves only still images. Because Herman et al. appear to be exclusively focused on still images, Applicants had traversed the assumption in the Office Action that one of skill in the art would consider Herman et al. to be “naturally accommodating to animation.” (See pages 8-9, Applicants’ previous response.) Accordingly, Applicants had argued that we have the weightier evidence that Herman et al. is non-analogous to references that relate to animation and that one of skill in the art would not have sufficient motivation to combine these references. Applicants have additional arguments regarding why one of skill in the art would not have sufficient motivation to combine these references but shall address this particular issue.

Applicants therefore have presented rebuttal evidence regarding the 103 combination of the references. In response, under the requirements of the MPEP, the Office is required to provide “explicit findings on motivation or suggestion” and to clearly articulate the rationale for combining. Applicants submit that the response to arguments on page 6 of the Final Office Action is insufficient in this regard. Specifically, Applicants submit that there is no discussion regarding why one of skill in the art, once it is established that Herman et al. only involve combining still images into a mosaic, would nevertheless have sufficient motivation or suggestion to combine Herman et al. with the other references. On page 6 of the Office Action, the responsive argument to Applicants’ position essentially does not articulate anything new.

The Examiner’s position is as follows:

“Herman et al. teaches wherein a mosaic image is generated from a set of source images such that the source images may include live images, images from various storage media, such as computer files, synthetically generated images, such as computer graphics, and processed images, such as previously constructed mosaic images, see column 4, lines 11-19 and 36-42....”

Applicants respectfully submit that this argument does not in any way address Applicants' position. The sum and substance of this argument is that the still images that are used to generate the mosaic may come from a variety of sources. Some of these sources may include images from video cameras, image scanners and so forth. Applicants do not dispute that the still images that are used to generate the mosaic may come from a number of sources. That fact does not change in any way Applicants' position. The passing reference to a variety of places from which the set of source, still images may be generated does not change the overall suggestive power of Herman et al. Fundamentally, it remains that Herman et al.'s teaching involves constructing an image mosaic that comprises a set of source images that are aligned and enhanced and merged to form an image mosaic. Therefore, the basic response in this final Office Action does nothing to respond to or rebut Applicants' position. There is no discussion why the set of still images, whether drawn from video or not, become a naturally accommodating to animation. A still image is a still image.

Furthermore, there is clearly no "articulation of how the conclusions are supported by the findings" MPEP 2144.08, Section III, paragraph 1. As best Applicants can understand, the Examiner the Examiner's position is that although Herman et al.'s image mosaic is only constructed from still images, because those still images may be gleaned from a video camera, that this somehow would cause one of skill in the art to believe that all of the principles of Herman et al. involving the manipulation of and construction of the still image mosaic would somehow apply to animation because those still images may involve a still image gathered from a video source. Applicants respectfully submit that this reasoning is simply not convincing and not persuasive. Applicants therefore maintain their position which has not been rebutted, which is that Herman et al. fundamentally create an image mosaic that only involves still images as the set of source images and that for this reason, namely, that Herman et al.'s entire disclosure

involves only processing and manipulating the set of source still images (whatever the source of those images may be) to construct that image mosaic results in this reference being non-analogous to the other references.

For this fundamental reason, Applicants also respectfully submit that the finality of the Office Action is inappropriate. MPEP 706.06(C)-(E) governs whether a final rejection is premature. Applicants submit that because the Examiner's response to arguments have not completely articulated or rebutted Applicants' specific position regarding whether one of skill in the art would have sufficient motivation or suggestion to combine these references, Applicants submit that the final rejection is premature and respectfully request withdrawal of the finality of the Office Action in order to both enter in the amendment to the claims as set forth above and discussed below and to fully consider and either issue a Notice of Allowance or provide an articulated response to Applicants' position. Applicants have been forced into filing this response in an RCE and request a refund of the fee in this regard.

There are further reasons why one of skill in the art would not have sufficient motivation or suggestion to combine these references. Applicants note that Noot et al. teaches receiving from the remote sender marked features on the file associated with the animated entity in the context of a background. Herman et al. is then asserted as teaching wherein as the animated entity moves an extrapolation method fills the voids between the animated entity and the background citing column 14, lines 14-44 for the concept of extrapolation to fill voids in the image boundaries. Applicants submit that there are reasons why one of skill in the art would not have sufficient motivation or suggestion to combine these references. First, Applicants note that fundamentally, as has been noted above, Noot et al. teach an animation approach and clearly Herman et al. teach a still image approach which is a primary hurdle that the Examiner has yet to articulate a convincing line of reasoning why one of skill in the art would nevertheless actually have more motivation than less motivation to combine. Additionally, with regard to the concept

of a background, Applicants submit that where Noot et al. may teach an animated entity alias may be provided in the context of background, that this conceptually and fundamentally differs from the overall teachings of Herman et al. in which, while there may be a number of images that may be selected as the source set, and furthermore wherein some images may be overlaid on other images as shown in Figure 3B, Applicants respectfully submit that in the context of the goal of Herman et al. to construct an image mosaic, one of skill in the art would actually be led away from the idea or the thinking that the images, for example, those shown in Figure 3B are actually “background” images. This is of course clearly established inasmuch as the various images shown in Figure 3B are blended such that a single larger image mosaic is constructed as is shown in Figure 4. In other words, there is no concept within the basic teachings of Herman et al. that any source image of the images shown in Figure 3B results in being a “background” to any other image.

As has been previously cited, Herman et al. teach that “the two major steps in the construction of a mosaic image is image alignment and the merging of the aligned image into a large, seamless mosaic image.” Column 1, lines 19-23. Therefore, because it is a “major step” in the processing of Herman et al. that none of the source images are actually a background to another source image, but they are merged into a “seamless” mosaic image, Applicants submit that the overall suggestive power of Herman et al., does not include the concept of one image in the set of images being in the forefront and another image of the set of images being in the “background”. This addresses the Examiner’s position on pages 6 and 7 of the Office Action in which the Examiner notes that Herman et al. further teaches wherein source images that do not cover the entire domain of the desired mosaic have regions around their boundaries that are filled using extrapolation such that source images are combined in such a way that an object from one source image appears to be in front of a background provided by another source image.

Applicants acknowledge that column 6 discusses one case in which the set of source images are

combined in such a way that an object from one image appears to be in front of a background provided by another image. What is taught here, however, is a single paragraph in a very lengthy patent in which the concept of cutting and pasting is described. Here, still in the context of constructing an overall blended seamless image mosaic, they explain that a first image can be “cut” along an intended foreground boundary such as a face and then the resulting pixels may be pasted into another image. The edges are then blended to avoid aliasing. Applicants respectfully submit that there are several reasons why this does not tip the balance in the favor of the Examiner’s position.

First, MPEP 2143.03, Section VI, requires that the prior art must be considered in its entirety, “as a whole including portions that would lead away from the claimed invention.” Applicants have in their favor the basic overall invention of Herman et al. as always requiring and involving utilizing a set of still images. The seamless mosaic is constructed in each case, even in the context of what is described in column 6, lines 16-27. Therefore, at best, column 6 provides the idea that one image may be cut from one portion of the mosaic and placed in another portion of the mosaic. Applicants therefore respectfully submit that it would require inappropriate hindsight (see MPEP 2141.01, Section III) to lend too much weight to the case discussed in the few lines of column 6 in the context of the overall objective suggestive power which may be gleaned from Herman et al. Applicants maintain that even though the concept of cutting an image along a boundary and then inserting the resulting pixels into another image does not somehow shift the balance of the overall suggestive power of Herman et al. such that one of skill in the art would have sufficient motivation to combine the overall teachings of this reference with Noot et al. or Gever et al. Applicants respectfully submit that it may even strengthen Applicants’ position because the concept of cutting the image from one portion of the mosaic to another portion of the mosaic nevertheless still requires there to be a set of still images, and still requires the images to be constructed into a large seamless mosaic image in which an

object from one image is simply cut and paste into another portion of the mosaic. Therefore, for this additional reason, Applicants maintain their position, that by a preponderance of the evidence, one of skill in the art would be unlikely to combine Herman et al. with Noot et al. and/or Gever et al.

Applicants had previously explained why, even if these references were combined, they would nevertheless fail to teach each limitation of the claims. Applicants discussed in detail the portion of column 14 regarding image boundaries. Applicants have explained that this portion of Herman et al. involves the issue introduced in Herman et al. in column 2, lines 10-17 in which the merging step involves filling any holes in the mosaic that are left by the lack of any source images to cover some portion of the desired mosaic domain. They explain that the method of filling holes in the mosaic uses a multi-resolution, pyramid image processing framework that has been scribed by a P. J. Burt article in 1988. This article is further discussed in the portion of column 14 cited by the Examiner in which the pyramid scheme is used for handling image boundaries so that holes may be filled in the mosaic between source images. This portion of the reference continues to support Applicants' position that this does not involve the concept of an extrapolation method that fills voids between an animated entity and a background.

First, as has been well discussed, Herman et al. do not discuss anything regarding an animated entity. Secondly, as has been further discussed as well, the image boundary pyramid method described in columns 2 and 14 do not involve filling voids between an animated entity and a background. To further clarify Applicants' position, claim 34 has been amended to recite that the first step involves receiving from the remote sender an image file having a portion associated with an animated entity and a portion associated with a background, the background and animated entity representing separate, non-seamless images. This amendment eliminates the ability of the Examiner to interpret the animated entity and the background as being what is taught in Herman et al. with regards to how one still image is treated when one still image such

as image 313 is behind another image such as 314 in Figure 3B. Applicants note that all the images in Figure 3B are blended in a line into a “large, seamless, mosaic image.” See column 1, lines 20-22. Inasmuch as this is part of the “major” steps of what is taught in Herman et al., when Applicants amend claim 34 such that the background in the animated entity in the claim represents separate images that are “non-seamless,” Applicants submit that this clearly distinguishes this claim from the disclosure of Herman et al. Accordingly, Applicants submit that claim 34 is patentable and in condition for allowance.

Therefore, Applicants respectfully submit that claim 34 and dependent claims 35 and 36 are patentable and in condition for allowance.

**Rejection of Claim 35 Under 35 U.S.C. §103(a)**

The Office Action rejects claim 35 under 35 U.S.C. §103(a) as being unpatentable over Gever et al. in view of Noot et al. and Herman et al. and further in view of Salesin et al. (U.S. Patent No. 5,666,475) (“Salesin et al.”). Applicants respectfully traverse the Examiner’s analysis on page 7 of the Office Action in response to our previous arguments that one of skill in the art would not have sufficient motivation or suggestion to combine Salesin et al. with Noot et al.

Applicants note a glaring inconsistency in the Examiner’s position. The Examiner on page 7 submits in response to Applicants’ argument that the concept of Salesin et al. would not be suggested because an original image is generated by a designer using the concepts disclosed in Noot et al. and Gever et al. In response, the Examiner argues that “Noot et al. teaches altering a current animation...such that the user may edit at any level of zooming...see pages 42-43, Section 6.2.4 Creating a new animation...” (Emphasis added.) Applicants note that this is a glaring inconsistency because the Examiner characterizes Section 6.2.4 which involves creating a “new” animation as actually teaching the opposite, namely, “altering a current animation.” This actually highlights Applicants’ position, Applicants’ position is that one of skill in the art would know that using Section 6.2.4, that one would create from “scratch” a new animation and



thus the production or the generation of an image that would have different resolution levels in different places as is the type of image that is the subject of Salesin et al. would not come into play. The concept of altering a current animation is discussed in Section 6.5 of Noot et al. The disclosure in this portion regarding editing an animation also does not hurt Applicants' position. Here, they explain that it is possible to perform editing operation in a full view, medium and small view for a fined editing of a single AP. Nevertheless, although the concept of editing an animation is discussed in Noot et al. and furthermore, although the concept exists of being able to edit in various views, there is no discussion regarding editing an image that has differing levels of resolution at different places as is the fundamental requirement of Salesin et al. Therefore, Applicants submit that Applicants' fundamental position has not been addressed, namely, that Section 6.2.4 of Noot et al. teach that all the newly-generated images taught in Noot et al. do not appear to have any different levels of resolution in different places within the image. Therefore, the concept of Salesin et al. would not likely lead one of skill in the art to combine these references. Furthermore, Applicants also note that Herman et al. should not be combined with Gever et al. and Noot et al. and thus, for this reason as well, Applicants submit that claim 35 is patentable and in condition for allowance.

Again, Applicants respectfully request entry of the above amendment and withdrawal of the finality of the Office Action inasmuch as the Office's response has not articulated a response to Applicants' position. In addition, Applicants have added several claims of the same general scope to claims 34-36 and request entry of these claims as well as allowance of the same.

**CONCLUSION**

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

By: 

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